

REMARKS

The undersigned contacted the Examiner by telephone on 3 June 2004 to request a telephonic interview. The Examiner indicated, by return voicemail, that she did not have possession of the case, but that the Applicant should file a response, and later interview the case if necessary. Accordingly, should any issues remain precluding allowance of the application, the Applicant respectfully requests a telephonic interview.

Claims 2, 17 and 29 have been amended. Claim 13 has been cancelled without prejudice. Claims 31-33 have been added. Claims 1, 3, 19-28 and 30 were previously withdrawn. With entry of this amendment, claims 2, 4-12, 14-18, 29, and 31-33 will be pending.

Independent Claim 2 and Dependent Claims 4-12, 14-18 and 31

Claims 2, 4-12, and 14-18 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Particularly, the Examiner contends that claims contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The Examiner suggests that if “applicants desire to exclude R¹ and R³ being oxygen-containing species, it is suggested that applicants list the species by excluding oxygen containing species.”

Applicant has amended independent claim 2 to recite R¹ being selected from the group consisting of a hydrogen atom, lower monovalent hydrocarbon groups, CH₂CH₂OH, CH₂CH₂CH₂OH, and lower heterogeneous groups having at least one heteroatom selected from the group consisting of nitrogen and sulfur. Support for this amendment can be found in the paragraph bridging page 13 to page 14 of the Applicant’s specification. Particularly, this portion specifies that R¹ may be CH₂CH₂OH or CH₂CH₂CH₂OH. In addition, support for the amendment can be found in the definitions for “heterogeneous group,” page 9, lines 19-29, and “heteroatom,” page 9, lines 6-9. Particularly, heterogeneous groups contain at least one heteroatom, and heteroatoms may be selected from the group consisting of nitrogen and sulfur. Withdrawal of the 112 rejection is respectfully requested.

Applicant has made the amendment to facilitate an allowance of the present application, but reserves the right to pursue any cancelled subject matter in a continuation or divisional patent application.

Claims 2, 4-10, 12, 14 and 15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,171,331 to Biddlecom ("Biddlecom"). Claim 11 stands rejected under 35 U.S.C. § 103(a) as being obvious over Biddlecom. Independent claim 2 includes the general compound structures from which the 2-decarboxy-2-phosphinic derivatives are selected, and recites a variety of phosphinic derivatives. The portions of Biddlecom cited by the Examiner show various phosphonic derivatives. Biddlecom's compounds cited by the Examiner each show an oxygen atom being double bonded to and two $-OCH_3$ bonded to the phosphorus atom. In other words, these compounds have three oxygen atoms directly bonded to the phosphorus atom. Independent claim 2 provides for, at most, two oxygen atoms being directly bonded to the phosphorus atom. Consequently, Biddlecom does not teach or suggest the subject matter of independent claim 2.

Claims 2, 4-12, and 14-18 stand rejected under 35 U.S.C. § 103(a) as being obvious over Kende et al (Tetrahedron Letters, 11-19-1999) in view of U.S. Patent No. 6,262,105 issued to Johnstone ("Johnstone"). Kende shows phosphonic derivatives, similar to those shown by Biddlecom. Structures 5 and 11 in Kende, to which the Examiner alluded, each have three oxygen atoms directly bonded to the phosphorus atom. Again, independent claim 2 provides for, at most, two oxygen atoms being directly bonded to the phosphorus atom. Johnstone does not cure this deficiency. Consequently, Kende and Johnstone, taken separately or combined, do not teach or suggest the subject matter of independent claim 2.

Claims 4-12 and 14-18 depend from allowable independent claim 2, and therefore, are allowable. Claims 4-12 and 14-18 may contain additional patentable features and/or combinations of features that may or may not be discussed herein. Reconsideration and allowance of claims 2, 4-12 and 14-18 are respectfully requested.

New claim 31 depends from allowable independent claim 2, and therefore is allowable. Claim 31 contains additional patentable subject matter. Particularly, claim 31 specifies that R^1 is not CH_2CH_2OH or $CH_2CH_2CH_2OH$. Consequently, new claim 31 is allowable. Consideration and allowance of new claim 31 are respectfully requested.

Independent Claim 29 and Claim 32

Independent claim 29 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Particularly, the Examiner contends that

claims contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The Examiner suggests that if "applicants desire to exclude R¹ and R³ begin oxygen-containing species, it is suggested that applicants list the species by excluding oxygen containing species."

Independent claim 29 has been amended to recite R¹ being selected from the group consisting of a hydrogen atom, lower monovalent hydrocarbon groups, CH₂CH₂OH, CH₂CH₂CH₂OH, and lower heterogeneous groups having at least one heteroatom selected from the group consisting of nitrogen and sulfur. Support for this amendment is discussed above with respect to claim 2. Withdrawal of the 112 rejection is respectfully requested.

Applicant has made the amendment to facilitate an allowance of the present application, but reserves the right to pursue any cancelled subject matter in a continuation or divisional patent application.

Independent claim 29 stands rejected under 35 U.S.C. § 103(a) as being obvious over Kende et al in view of Johnstone. As discussed above with respect to independent claim 2, Kende discloses phosphonic derivatives. Structures 5 and 11 in Kende, to which the Examiner alluded, each have three oxygen atoms directly bonded to the phosphorus atom. Independent claim 29 provides for, at most, two oxygen atoms being directly bonded to the phosphorus atom. Johnstone does not cure this deficiency. Consequently, Kende and Johnstone, taken separately or combined, do not teach or suggest the subject matter of independent claim 29.

New claim 32 depends from allowable independent claim 29, and therefore is allowable. Claim 32 also contains additional patentable subject matter. Particularly, claim 32 specifies that R¹ is not CH₂CH₂OH or CH₂CH₂CH₂OH. Consequently, new claim 32 is allowable. Consideration and allowance of new claim 32 are respectfully requested.

New Independent Claim 33

New independent claim 33 is substantially the same as claim 13, to which the Examiner objected, except rewritten in independent form. In addition, the phrase "wherein R¹ and R³ are not both oxygen-containing moieties" has been deleted. Allowance of this independent claim is respectfully requested in view of the Examiner's indication that cancelled claim 13 contained patentable subject matter.

CONCLUSION

In view of the foregoing, claims 2, 4-12, 14-18, 29, and 31-33 are allowable. Reconsideration and allowance of the application are respectfully requested. Should any issues remain precluding allowance of the application, the Examiner is encouraged to contact the undersigned by telephone to coordinate a telephonic interview as requested above.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'G. J. Hartwig', with a large, stylized flourish extending from the end of the signature.

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